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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURTIS C. BALLARD

Appeal 2007-3064
Application 10/007,116[1]
Technology Center 2100

Decided: March 31, 2008

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and CAROLYN D. THOMAS, *Administrative Patent Judges.*

THOMAS, C., *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 2-12, 14-20, and 22 entered August 11, 2005. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] Application filed November 7, 2001. The real party in interest is Hewlett-Packard Development, L.P.

A. INVENTION

Appellant invented a system and method directed to a data collection and transmittal system for a networked device where the networked device performs a stand alone dedicated function and comprises data collection logic, message generation logic, and a communication system. (Spec., ¶ 6.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 2-12, 14-20, and 22. Claims 12 and 22 are independent claims. Claims 1, 13, and 21 are canceled and claims 23-25 are withdrawn from consideration. Claim 22 is illustrative:

> 22. A data collection and transmittal system, the system comprising:
>
> a networked device, connected to a digital network, performing a dedicated standalone function;
>
> data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function;
>
> message generation logic configured to recognize a trigger event, associated with networked device's ability to perform said standalone function, and configured to generate an electronic message containing at least a portion of said collected information; and
>
> a remote server configured to receive said electronic message over said digital networked and to determine an action to be taken with respect to said networked device.

C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Oskay	US 5,642,337	Jun. 24, 1997

Reichman	US 6,738,813 B1	May 18, 2004 (Filed Sep. 11, 2000)
Moberg	US 6,738,826 B1	May 18, 2004 (Filed Feb. 24, 2000)
Conrad	US 6,892,236 B1	May 10, 2005 (Filed Mar. 16, 2000)

D. REJECTIONS

The following five (5) rejections are before us for review:

1) Claims 2, 3, 5, 6, and 22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Conrad;

2) Claims 4, 7, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conrad and Reichman;

3) Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conrad, Reichman, and Oskay;

4) Claims 11 and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conrad, Reichman, and Moberg; and

5) Claims 12, 14, 15, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conrad and Moberg.

II. PROSECUTION HISTORY

Appellant appeals from the Final Rejection and filed an Appeal Brief (App. Br.) on February 23, 2006. The Examiner mailed a corrected Examiner's Answer (Ans.) on February 8, 2007. Appellant filed a Reply Brief (Reply Br.) on January 19, 2007.

III. ISSUE(S)

Whether Appellant has shown that the Examiner erred in rejecting the claims as being anticipated by Conrad and/or obvious over the combination of cited references.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1. The ordinary and usual meaning of "stand-alone" is a device that is self-contained and that does not require any other devices to function. *http://www.webopedia.com/TERM/S/stand_alone.html*

Conrad

2. Conrad discloses "reporting of operation characteristics of components of a computer system." (Col. 1, ll. 9-10.)

3. Conrad discloses a "performance reporting framework that includes a plurality of reporting clients that concentrate on tracking and reporting performance data for various system components and one or more reporting servers for receiving the collected data from the reporting clients and generating performance reports from the received data. Each reporting client tracks component-specific metrics of interest for monitoring one or more system components." (Col. 2, ll. 26-34.)

4. Conrad discloses that a "component may be considered as a binary image or a set of binary images that work together to provide a service. . . . Examples of . . . services include audio and video recording/playback, USB

device support, windowing services, file system management, and memory management." (Col. 5, ll. 26-34.)

5. Conrad discloses that "a plurality of reporting clients 83-89 that are responsible for collecting statistical data relating to network performance of different system components." (Col. 5, ll. 55-58.)

6. Conrad discloses that the "reporting system may optionally have higher levels of reporting servers that receive data from reporting servers on a lower layer and generating a report of a higher level of abstraction than those of the lower level servers, . . . suitable for reviewing the health or status of multiple sets of system components." (Col. 6, ll. 4-14.)

7. Conrad discloses that "[t]he division of the reporting system into reporting clients for collecting data and reporting servers for generating reports also makes it easier to modify the reporting system to accommodate changing reporting requirements." (Col. 6, ll. 49-52.)

8. Conrad discloses that "the invention will be described in the general context of computer-executable instructions, such as program modules, being executed by a personal computer." (Col. 3, ll. 34-36.)

Moberg

9. Moberg discloses "receiving a failover message at a currently active packet switching device (A), . . . de-activating a current packet switching device (A) and activating a standby packet switching device (B) to handle packet flow previously handled by the packet switching device (A), thereafter reprogramming the packet switching device (A), and thereafter deactivating the packet switching device (B) and re-activating the packet switching device (A)." (Col. 1, l. 55 – col. 2, l. 3.)

V. PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

VI. ANALYSIS

Grouping of Claims

In the Brief, Appellant argues claims 2-11 and 22 as a group (App. Br. 5-7 & 9-10). In other words, for claims 2-11, Appellant merely repeats the same argument made for claim 22. Thus, the Board selects representative

claim 22 to decide the appeal for this group. Accordingly, the remaining claims in this group stand or fall with claim 22.

Appellant argues claims 12 and 14-20 as a group (App. Br. 8-10). For claims 14-20, Appellant merely repeats the same argument made for claim 12. We will, therefore, treat claims 14-20 as standing or falling with claim 12. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991).

The Board's Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

To determine whether Conrad anticipates representative claim 22, we must first determine the scope of the claim. Our reviewing court stated in *Phillips v. AWH Corp.,* 415 F.3d 1303, 1315 (Fed. Cir. 2005), *cert. denied, sub nom. AWH Corp. v Phillips*, 546 U.S. 1170 (2006):

> The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d [967] at 978 [Fed. Cir. 1995], consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." 90 F.3d at 1582.

We note that Appellant has not identified any specific definition for the term "stand-alone," nor has Appellant identified any special definition in the art for this term. From our review of the original Specification, Appellant has not shown, and we do not readily find an express definition of the aforementioned term in the Specification. Therefore, we give this term its ordinary and customary definition and find that "stand-alone" designates a device that is self-contained and that does not require any other devices to function (FF 1).

The Anticipation Rejection

We first consider the Examiner's rejection of claims 2, 3, 5, 6, and 22 under 35 U.S.C. § 102(e) as being anticipated by Conrad.

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

Appellant contends that "neither the 'computer system components' nor the 'reporting devices' described by *Conrad* meet the limitations claim 22 places on 'network device[s].'" (App. Br. 6.) Appellant further contends that "computer-system components do not perform dedicated, stand-alone functions. . . . *Conrad* cannot have 'data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function,' as no aspect of *Conrad* reports on the performance of the 'reporting clients.'" (App. Br. 6-7 and 9.) Further, Appellant contends that the "'computer system components' of *Conrad* do not perform a 'dedicated stand-alone function.'" (Reply Br. 3.) We disagree.

The Examiner found that "the statistical data that is collected [in Conrad] is in direct connection to a function that is repeatedly done by the hosts or computer system components in the network" (Ans. 14).

Further, Conrad discloses a system and method for reporting performance of computer system components (FF 2). In Conrad, reporting clients, e.g., personal computers, track and report on performance data for various system components (FF 3 & 8), whereby the components may be considered as a binary image that provides a service including memory management (FF 4). We find that a personal computer is a stand-alone device, when performing file/memory management for example. Conrad further discloses that the reporting clients are responsible for collecting data relating to network performance of different system components (FF 5).

In other words, Conrad discloses a networked device, i.e., a reporting client, which performs a stand-alone function, i.e., memory management, whereby the reporting client collects data relating to the performance of the components. Thus, we find that Conrad's reporting client can act as a stand-alone device and can perform a stand-alone function and collect data pertaining to the performance thereto.

Based on our findings and those of the Examiner, we do not find that Appellant has shown error in the Examiner's rejection of exemplary claim 22. Instead, we find the Examiner has set forth a sufficient initial showing of anticipation, and Appellant has not shown that Conrad lacks the above-noted disputed features of claim 22. Therefore, we affirm the rejection of independent claim 22 and of claims 2, 3, 5, and 6, which fall therewith.

The Obviousness Rejection

We now consider the Examiner's rejection of claims 4, 7-12 and 14-20 under 35 U.S.C. § 103(a) as being obvious over the combination of cited references.

Claims 4 and 7-11

For claims 4 and 7-11, Appellant merely repeats the same argument made for claim 22. Therefore, for the reasons noted *supra* regarding claim 22, we affirm the rejection of claims 4 and 7-11.

Claims 12 and 14-20

Appellant contends that "[n]either *Moberg* nor *Conrad*, however, analyze messages to determine an appropriate modification." (App. Br. 9.)

The Examiner found that Conrad teaches "automatically analyzing said message . . ., but does not specifically teach to determine an appropriate modification of said network device" (Ans. 12). We disagree.

Not only does Conrad disclose generating a report of higher level of abstraction that is suitable for reviewing the health or status of multiple sets of system components (FF 6), but Conrad also discloses that the division of the reporting system into reporting clients for collecting data and reporting servers for generating reports also makes it easier to modify the reporting system to accommodate changing reporting requirements (FF 7). Thus, we find that Conrad discloses that *modification of the reporting system* is made easier by analyzing the reports. Therefore, we find that not only does Conrad disclose automatically analyzing the message, but Conrad also discloses determining an appropriate modification for the reporting system based on the analysis.

Cumulative to Conrad, the Examiner further found that "Moberg teaches automatically analyzing said message to determine an appropriate modification of said network device" (Ans. 12). We agree.

Moberg discloses receiving a failover message and thereafter replacing software controlling active routers (FF 9). Thus, we find that Moberg discloses analyzing a message to determine an appropriate modification of a networked device.

Appellant further contends that the "Examiner has failed to provide any motivation for combining features of *Conrad* and *Moberg* for the purposes of rejecting cla[i]m 12. Instead, the Examiner merely refers to the motivation provided for claim 11." (App. Br. 8.) Appellant further contends that "*Conrad* and *Moberg* describe completely different systems, and one would need to substantially modify *Conrad* in order to perform any function from *Moberg*." *Id.*

The Examiner concluded that "Conrad and Moberg are not so far apart in technologies that it would take substantial unspecified alterations to add the inventions together" (Ans. 16). We agree.

In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739 (2007), the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.
In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent

that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

We have considered all of Appellant's arguments in the Briefs, but we are not persuaded of error in the rejection of claim 12. We find that replacing software in the Moberg system, in an active component, for the reasons identified by the Examiner, represents no more than the predictable use of prior art elements according to their established functions, yielding predictable results.

Therefore, we do not find that Appellant has shown error in the Examiner's rejection of exemplary claim 12. Instead, we find the Examiner has set forth a sufficient initial showing of obviousness, and Appellant has not shown that the combination of Conrad and Moberg lacks the above-noted disputed features of claim 12. Therefore, we affirm the rejection of independent claim 12 and of claims 14-20, which fall therewith.

As for the Reichman and Oskay references, Appellant merely argues that neither reference teaches or suggests the above-noted limitations

without providing any meaningful analysis that explains why the Examiner erred. (App. Br. 9.) A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). We note that arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

VII. CONCLUSIONS

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 2-12, 14-20, and 22.

VIII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejections of claims 2-12, 14-20, and 22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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